

REMARKS

Applicants appreciate the consideration of the present application afforded by the Examiner. Claims 1-92 remain pending. Claims 1-8, 49-50, and 63-66 are independent. Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks.

Claim Rejections - 35 U.S.C. §103(a)

Claims 1-8, 13-70, and 75-92 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Pub. No. 2003/0105950 to Hirano et al. ("Hirano") in view of U.S. Patent No. 7,366,301 to Huang et al. ("Huang"). Claims 9-12 and 71-74 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hirano in view of Huang and further in view of U.S. Pub. No. 2004/0119726 to Li ("Li").

Applicants submit the Examiner has failed to establish a *prima facie* case of obviousness and continue to traverse the rejection.

For a 35 U.S.C. § 103 rejection to be proper, a *prima facie* case of obviousness must be established. *See M.P.E.P. 2142*. One requirement to establish *prima facie* case of obviousness is that the prior art references, when combined, must teach or suggest all claim limitations. *See M.P.E.P. 2142; M.P.E.P. 706.02(j)*. Thus, if the cited references fail to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

In the final Office Action, the Examiner corresponds the disclosure of Hirano to the features of claim 1 regarding

*"extracting a specific color portion of the received color image data, when the authentication is not completed; and
deleting the extracted specific color portion from the received color image data"*

(see Office Action, pp. 2-3). The Examiner expressly concedes that Hirano is silent regarding the features of

*"the color image data comprises a plurality of colors, and consists of the specific color portion and a non-specific color portion other than the specific color portion;
the specific color portion is represented by a specific color among the plurality of colors;*

the non-specific color portion is represented by a non-specific color, other than the specific color, among the plurality of colors”

(see Office Action, p. 3), and he relies upon Huang to allegedly cure this conceded deficiency of Hirano by corresponding the disclosure of Huang to these features.

Even assuming, *arguendo*, the propriety of such a correspondence between the disclosures of the references to the claimed features, respectively, which Applicants do not necessarily concede, the combination of Hirano and Huang still fails to teach or suggest at least the features of claim 1 regarding the association between the above features of claim 1.

Hirano may disclose concealing or revealing secret document information based on the result of a user authentication process. Hirano is directed towards a document distribution and management method generally involving access control and authentication procedures. Hirano states that if the user authentication is not completed successfully, the secret information portion is concealed in the secret information display portion by using covering characters, such as asterisks. (See Hirano, ¶ [0489]; Figures 71-73.) Otherwise, if the authentication is successful, the secret information is acquired and displayed. (See Hirano, ¶¶ [0493]-[0494].)

However, Hirano fails to disclose or suggest utilizing a color image data that comprises a plurality of colors, and consists of a specific color portion and a non-specific color portion other than the specific color portion as an object in order to perform the extraction and deletion of the specific color portion based on a result of a user authentication procedure.

The Examiner is relying on the disclosure of Huang to allegedly provide a teaching by which one of ordinary skill in the art would modify Hirano to extract a specific color portion of a color image data based on user verification. (See Office Action, p. 3-4). However, neither reference provides such a teaching. Furthermore, the Examiner’s stated motivation for the combination of the references is clearly deficient and unreasonable.

First, the Examiner states, on page 4, lines 13-16 of the Office Action, that

“it will be obvious to one ordinary skilled in the art at the time the invention was made to modify Hirano’s image data to include Huang’s pluralities of colors such as RGB and CMYK so that secret information can be distinguished from non-secret information [sic].” (Emphasis added.)

On the contrary, although Huang may teach a multicolored document, Huang does **not** teach that secret information corresponds to any specific color among a plurality of colors.

Huang does not involve secret and non-secret information in any respect. Instead, Huang is expressly directed towards verifying whether a color document is authentic or not by analyzing a multilayer optical watermark. This is achieved by embedding multiple latent image objects into the watermark by phase or other modulation. (See Huang, col. 3, lines 26-40.) The latent image object in the watermark can only be viewed using an optical decoder corresponding to a particular layer, such as specially designed lens with gratings defined by periodic functions, and the document is verified in this manner. (See Huang, col. 2, lines 53-55.)

Although Huang teaches that the watermark may be used with a color document (see col. 13, lines 41-45), Huang is silent regarding any sort of secret information within the document at all, much less utilizing any portion of the color document as an object to be extracted and deleted on the basis of the results of an authentication process. Absent any such teaching, the mere fact that the document to be verified in Huang is a color document cannot cure the deficiency of Hirano and does not teach or suggest the association between the features as recited in claim 1. At best, a combination of the teachings of Hirano and Huang might result in concealing secret portions of a color document with asterisks. (See Hirano, ¶ [0489]; Figures 71-73.) However, the combination of references does not render obvious “*extracting a specific color portion of the received color image data, when the authentication is not completed*” and “*deleting the extracted specific color portion from the received color image data*” when authentication is not completed, as recited in independent claim 1.

Second, the Examiner states that one of ordinary skill in the art would be motivated to modify Hirano in view of Huang “to prevent forging of some confidential document as such bill of lading or a check [*sic*].” (Office Action, p. 4, lines 16-17.) In other words, the Examiner appears to imply that a forging of a confidential document such as a bill of lading or a check is prevented by modifying Hirano’s image data to include Huang’s pluralities of colors, such as RGB and CMYK, and then by distinguishing the secret information from the non-secret information.

The Examiner's rationale **does not make sense**. There is **no advantage** for preventing the forging of a confidential document, such as a bill of lading or a check, to distinguish a secret information portion from non-secret information portion of information in the document according to a specific color portion among a plurality of colors. As previously discussed, Huang is wholly unconcerned with concealing or deleting secret information; instead, the watermark disclosed by Huang is used only for verification of the legitimacy of a **document** as a whole. In contradistinction, Hirano is expressly directed to authenticating a **user** in order to determine whether to conceal secret information from that user. These are entirely different issues.

In this instance, it appears that the only motivation to combine the references has been gleaned from the teachings of the present application. This constitutes impermissible hindsight, however. See MPEP 2141. Simply put, there is no showing in the Office Action that the conclusion of obviousness was reached on the basis of facts gleaned from the prior art, and not from the claimed invention. See MPEP 2143.

The Applicants respectfully submit that the Office Action is based upon a selective combination of features found in the two references, and that such selective combining is impermissible. As stated in *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985), "When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." It is respectfully submitted that the Office Action cites the Hirano publication and then utilizes the present application to provide the motivation to selectively replace various features of the Hirano reference.

In this instance, the combination of Hirano and Huang fails to teach or suggest each and every limitation of claim 1. Independent claims 2-8, 49-50, and 63-66 recite at least features comparable to those discussed above with respect to independent claim 1. Dependent claims 9-48, 51-62, and 67-92 are also distinguishable from the prior art at least due to their dependence from the independent claims, directly or indirectly.

Therefore, Applicants submit that claims 1-92 are patentable over Hirano in view of Huang and respectfully request that the rejection of claims 1-92 under §103(a) be withdrawn.

CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Notice of same is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John R. Sanders (Reg. No. 60,166) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: December 4, 2009

Respectfully submitted,

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